

REMARKS

Claims 1-5 and 7-11 are pending in this application. Claims 1 and 7-11 stand rejected and claims 2-5 are objected to. Applicant acknowledges the Examiner's indication that claims 2-5 contain allowable subject matter. Applicant refrains from rewriting those claims in independent form until final resolution of the underlying independent claims. In light of the remarks set forth below, Applicant respectfully submits that each of the pending claims is in immediate condition for allowance.

Paragraphs 3 and 4 of the Office Action reject claims 1 and 7-11 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,805,694 ("Kim") in view of U.S. Patent No. 4,980,910 ("Oba"). Applicant respectfully requests reconsideration and withdrawal of this rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See, M.P.E.P. § 706.02(j). A reference can only be used for what it clearly discloses or suggests. See, In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). Here, the references, whether taken individually or in combination, do not disclose or suggest the invention claimed by the Applicant.

Claim 1 explicitly recites “a controller ... further adapted to retrieve a plurality of redial phone numbers from said first and second memory, said phone numbers being related to said registered phone numbers for sequential dialing, until a connection is made.” Likewise, claim 7 recites selecting one of the redial phone numbers stored in the redial number memory; retrieving a plurality of registered phone numbers related to said selected redial number from the phone directory memory; and redialing a selected one of the retrieved registered phone numbers depending on a call instruction further comprising the step of repeating the step while sequentially selecting the retrieved registered phone numbers until a connection is made.

The Office Action asserts that the above-recited limitation is disclosed in Kim at column 2, line 56, through column 3, line 65 as well as column 1, line 66, through column 2, line 3, and, Figure 2. Applicant respectfully disagrees with this interpretation of Kim.

In Kim, as shown in Figure 2, a number is dialed and stored. If the line is busy, the number can be redialed. If the line is not busy, the system in Kim assumes that a connection is established (see box 103 establish communication). In the instance when the line is busy, the telephone number to be dialed is displayed. The phone number can then be edited and redialed. However, only the last digit of the phone number can be edited. Further, while column 1 states that it is an object to provide an enhanced redialing feature able to selectively and alternately shift among a plurality of numbers assigned to a subscriber while endeavoring to establish a telephone connection between the person using this enhanced feature and the

subscriber (see, column 1, line 65 through column 2, line 3), as fully described in the detailed description of the invention, the entire invention relates to the ability to edit the last digit of the displayed phone number. Or, alternatively, the user can redial the previously dialed number if the last digit is not edited. However, Kim fails to disclose Applicant's explicitly recited limitation of sequentially dialing numbers from memory related to a given number until the call is completed. As such, Applicant respectfully submits that Kim does not teach the above recited limitation.

The Office Action includes Oba to disclose features that the Office Action recognizes that Kim does not possess. Whether or not Oba teaches these features is irrelevant as the combination of Oba and Kim does not cure the deficiencies in Kim discussed above. As such, Applicant respectfully requests reconsideration and withdrawal of the rejection and allowance of claims 1 and 7.

Claims 2-5 and 9-11 depend from either directly or indirectly, and contain all the limitations of claim 1. These dependent claims also recite additional limitations which, in combination with the limitations of claim 1, are neither disclosed nor suggested by Kim and are also believed to be directed towards the patentable subject matter. Thus, claims 2-5 and 9-11 should also be allowed.

Claim 8 depends from, and contains all the limitations of claim 7. This dependent claim also recites additional limitations which, in combination with the limitations of claim 7, are neither disclosed nor suggested by Kim and are also believed to be directed towards the patentable subject matter. Thus, claim 8 should also be allowed.

Applicant has responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

Dated: July 28, 2004

Respectfully submitted,

By

Ian R. Blum

Registration No.: 42,336

DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP

1177 Avenue of the Americas

New York, New York 10036-2714

(212) 835-1400

Attorney for Applicant

IRB/mgs